

In the Office Action dated 13 February 2001 a list of references was identified as an improper information disclosure statement. Claims 10-12 and 24-26 were identified as being drawn to a nonelected species, and henceforth these claims were withdrawn from further consideration. Claim 20 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-9, 13, 16-19, 22, 23 and 27-30 were rejected under 35 U.S.C. § 102(a) as being anticipated by the E. Excel products website. Claims 1-9, 13, 16-19, 22, 23 and 27-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over E. Excel products, further in view of Desert Lil's Delicacies and Van Wessern *et al.* (US 3,227,616). Applicant respectfully submits that in light of the claim and amendments and the arguments outlined below, such rejections are no longer applicable. Accordingly, Applicant respectfully requests that the claims be allowed.

In regard to the Office Action, paragraph 2, exception was noted to the listing of references in the specification. Pursuant to 37 C.F.R. 1.56 and M.P.E.P. § 2001.06(b) Applicant has, "a duty to bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other *copending* United States applications which are 'material to patentability' of the application in question." (emphasis added). The list of copending applications is provided as a courtesy to the examiner and to comply with the aforementioned duty.

With respect to the Office Action, paragraph 5, claim 20 is amended above to comply with 35 U.S.C. § 112, second paragraph. As such, claim 20 has sufficient antecedent basis and is now believed to be in a condition for allowance.

Regarding the Office Action, paragraph 6, claim rejections were based on 35 U.S.C. § 102(a), more specifically, the claims were stated as anticipated by the E. Excel products website (<http://www.eexcel.net>) which has a 1998 copyright. The E. Excel products website was published after 28 June 1998, which is less than one year before the filing date, but still allows for proper copyright designation of 1998. (Please see attached document marked "Exhibit A" -- registry information from Network Solutions for the E. Excel products website). Accordingly, Applicant now believes the 35 U.S.C. 102(a) rejections based on this website can be properly withdrawn.

With respect to the Office Action, paragraphs 7, 8 and 9, the claim rejections based on 35 U.S.C. § 103(a) can now be withdrawn in light of the new evidence of the web side publication date. If the E. Excel product website disclosures are less than one year from the filing date, as demonstrated by Applicant, then the 35 U.S.C. 103(a) rejections set forward in paragraphs 7, 8 and 9 can be properly withdrawn. Moreover, Applicant believes that impermissible notice has been taken that sources of ginseng are well known. Paragraph 8 states, "E. Excel products do not disclose the source of their ginseng (applicant's claims 14 and 15)." Applicant finds this statement confusing for two reasons. First, the E.Excel products website does in fact state the source of the ginseng, which is the ginseng berry extract. (See <http://www.eexcel.net>). Second,

the Applicant does not understand the Office Action reference to claims 14 and 15, as these dependent claims are in reference to the cactus fruit extract, rather than a ginseng berry extract.

Additionally and in particular respect to paragraph 9, Applicant argues that there is lack of suggestion to combine the references as discussed in the Office Action, paragraph 9, other than through impermissible hindsight reasoning. The Office Action, paragraph 9, states "E. Excel products do not list ginseng extract in their formulations" and as previously noted in this Applicant response, this statement is confusing. The E. Excel products website (submitted as evidence in the last response) contains numerous references to ginseng berry extract. (See <http://www.eexcel.net/elementefull.htm> - page 1, paragraph 3, "a blend of ginseng berry, cactus fruit, and grape seed extracts").

As discussed in M.P.E.P. § 2143.01, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. The remainder of the Office Action, paragraph 9 is dedicated to prior art which teach the use of ginseng root for inhibiting sebum secretion, ginseng for hair loss, and ginseng as an insecticide. Accordingly, Applicant believes the Office Action, paragraph 9 has improperly construed information in Applicant's website and there is lack of suggestion in the prior art of the desirability of combining references.

It is believed that the above remarks are responsive and have addressed each and every issue raised in the Office Action mailed 13 February 2001. Therefore, it is believed that the amended application stands with allowable claim subject matter, in light of the prior art of record. Applicant appreciates the Examiner's generous response and efforts regarding this invention.

### **CONCLUSION**

Applicant respectfully asserts that the foregoing limitations are not taught in the prior art. Accordingly, Applicant believes that the amendments should place the application in a condition for allowance, and respectfully requests the same. It is believed that the foregoing changes find support in the specification and accordingly are not new matter.

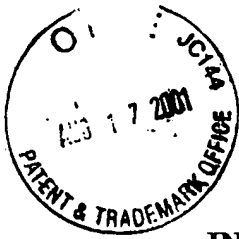
Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE.**" Should the Examiner wish to discuss any of the proposed changes or any other issue regarding this response with the new attorney of record, Applicant invites the Examiner to do so by telephone conference.

Respectfully submitted,



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Original Docket No. 7537.29  
New Docket No. 13246.0007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:	Jau-Fei Chen	)	
		)	Examiner: P.E. McQueeney
Application No.:	09/298,245	)	
		)	Group Art Unit: 1615
Filed:	23 April 1999	)	
		)	Docket No. 13246.0007
For:	CACTUS FRUIT SKIN CARE PRODUCTS	)	
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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims:**

Please amend claim 20 as follows:

20. The topical skin application of claim 13 [wherein] further including [a] botanical ingredient that is an herb.